predecessor in title, first used the mark CASCADE on whiskey in the year 1870, that CASCADE whiskey has been advertised in newspapers, magazines, trade publications and has been the subject of outdoor advertising, direct mail advertising, and point-of-sale advertising.

Since the parties are using the identical mark, the only issue is whether or not the concurrent use of CASCADE upon the respective goods of the parties is likely to cause confusion or mistake, or to deceive purchasers within the meaning of 15 U.S.C. 1052(d).

Appellant contends that "Diversification of industrial enterprises (a pattern with which the general public is familiar) has produced many conglomerate acquisitions 'in which there is little or no discernible relation between the business of the purchasing and the acquired firm.'" Consequently, it is urged that it would not be unusual for members of the general public to believe that some connection existed between the producers of the whiskey and the prepared baking mix bearing the identical trademark. Also, appellant urges that it should prevail because use of CASCADE by appellee will dilute its trademark upon which it has spent approximately $5,000,000 in advertising and under which it has sold about sixty million dollars worth of whiskey.

Appellee, on the other hand, contends that the respective goods upon which the parties use the trademark CASCADE are so unrelated as to preclude likelihood of confusion, mistake or deception. Appellee argues that the public is well aware of the fact that the same trademark may be used by a number of manufacturers on a variety of goods.

[1] First it may be well to consider appellant's statement, in support of its position, that it should prevail because "The public would conclude that each product was made by the same company, or by related companies, and by this confusion of sources the value of the trademark 'CASCADE' of Appellant is diluted and weakened." We believe that if there is likelihood of purchaser confusion the opposition should be sustained regardless of the question of whether use by appellee dilutes the mark. On the other hand, if likelihood of confusion does not exist, use by appellee of CASCADE for its prepared baking mix, which use might dilute the selling power or whittle away the mark's uniqueness, cannot be considered by us as a basis for rendering judgment in favor of appellant because without purchaser confusion there can be no "dilution."

[2] As to the question of likelihood of confusion, we are of the opinion that the use by appellee of CASCADE for prepared baking mix and the use of the same mark by appellant for whiskey is not likely to cause purchaser confusion. We agree with the board, which stated:

> * * * baking mix and whiskey are so totally unrelated in all material respects that purchasers thereof would not be likely to assume that they originate from a single source merely because of the identity of the marks.

Appellant argues that since both products are made from grain that this factor would cause confusion among purchasers. We do not believe that the purchasers of these products are likely to be confused because of this fact.

We have considered appellant's contention that, because of the policy of many companies to make and sell diversified products, purchasers of its whiskey are likely to conclude that it is now marketing prepared baking mix. However, we do not believe appellant has correctly analyzed this proposition.

[3] It is true that there is great diversification of products by companies these days but that fact in and of itself does not portend that purchaser confusion will be likely whenever a company uses a trademark for one product and another company uses the same trademark for an unrelated product. Although the public may be aware of this diversification, it is also aware of the fact that companies usually have different trademarks for their various diversified products.

There may be some instances where a widely known arbitrary trademark is being used for diversified products emanating from one source and confusion would be likely if a newcomer used the same mark on unrelated goods, but there is nothing in the record which convinces us that the public would consider that CASCADE, being used by appellant only for whiskey, falls into that category.

For the foregoing reasons we *affirm* the decision of the board.

SMITH, Judge, dissenting, with whom RICH, Judge, joins.

The mark "CASCADE" which the parties use for their respective goods is an arbitrary and fanciful mark and, as such, may become a strong indicator of source or origin of the goods to which it is applied. As such, I think the first user thereof is entitled to prevail in this opposition to registration by another of this mark for other goods. The opinions of the Trademark Trial and Appeal Board and the majority seem to base their dismissal of the opposition solely on differences in the goods to which the mark is applied by the respective parties. While differences in the goods is a factor which must be weighed in each opposition proceeding for its bearing on the likelihood of confusion, I do not think differences in goods per se is the controlling factor in such a proceeding. As pointed out in Hollywood Water Heater Co. v. Hollymatic Corporation, 47 CCPA 782, 274 F.2d 679, 124 USPQ 452, the question we must pass on under the Lanham Act is not solely whether the goods are similar or dissimilar but rather is whether the average purchaser would ascribe a common source or origin to the dissimilar goods *sold under identical marks*. In the present case, I think it is likely that the purchasing public would ascribe a common source or origin to whiskey and baking mixes where both are sold under the name "CASCADE."[1] I would, therefore, reverse the Trademark Trial and Appeal Board.

[1] The relation between whiskey and food products is closer than is suggested by the majority opinion. The well-known "bourbon" whiskey candies and the widespread use of whiskey as a flavoring constituent in "whiskey" cake, which are facts of which I would take judicial notice, may well suggest to an average purchaser that a "CASCADE" cake mix could well originate from the same source as "CASCADE" whiskey.

50 CCPA 1312

Court of Customs and Patent Appeals

In re JANAKIRAMA-RAO

Appl. No. 6997 Decided June 10, 1963

PATENTS

1. Claims — "Comprising," "consisting," etc. (§ 20.30)

Patentability—Composition of matter (§ 51.30)

Words and phrases (§ 70.)

Claim to glass resulting from fusion of a batch of glass forming compounds, consisting essentially of cadmium oxide, bismuth oxide, and silica, is not so restricted by "consisting essentially of" that it defines subject matter patentable over reference merely because glasses of reference contain some modifying ingredients in addition to silica, cadmium oxide, and bismuth oxide; "essentially" opens claim to inclusion of ingredients which would not materially affect basic and novel characteristic of applicant's compositions as defined in balance of claim; since no basic or novel characteristic to be so affected can be deduced from disclosure and since none was shown in brief or argument, there is no showing of properties patentably distinguishing applicant's claimed glasses from those of reference.

Particular patents—Glasses

Janakirama - Rao, Cadmium - Bismuth Glasses, claims 1 to 3, 6, 7, 10, and 11 of application refused.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Bhogaraju V. Janakirama-Rao, Serial No. 534,529, filed Sept. 15, 1955; Patent Office Division 5. From decision rejecting claims 1 to 3, 6, 7, 10, and 11, applicant appeals. Affirmed.

DONALD S. COHEN, Philadelphia, Pa., for appellant.

CLARENCE W. MOORE (GEORGE C. ROEMING of counsel) for Commissioner of Patents.

Before WORLEY, Chief Judge, and RICH, MARTIN, SMITH, and ALMOND, Associate Judges.

RICH, Judge.

This appeal is from the decision of the Patent Office Board of Appeals affirming the rejection of claims 1, 2, 3, 6, 7, 10, and 11 of application Ser. No. 534,529, filed September 15, 1955, for "Cadmium-Bismuth Glasses."

Appellant's specification shows that his glasses are composed of *three* primary constituents: a cadmium compound (e.g., cadmium oxide, CdO); a bismuth compound (e.g., bismuth oxide, Bi_2O_3); and a network former (e.g., silica, SiO_2). A modifier (e.g., tungsten oxide, WO_3) may also be used if desired.

The significance of the cadmium compound, appellant's application says, is to provide "cadmium ions" which were known at the time of his invention to aid in the formation of a moisture-resistant, neutron-absorbing glass having a high refractive index and good light transmission qualities.

The bismuth compound is primarily significant in appellant's glass to provide "bismuth ions," which appellant says were known at the time of his invention to aid in the formation of a glass having a high dielectric constant, a low dissipation factor, good stability, and easy workability. The bismuth compound is important for the further reason, appellant's application states, that "bismuth has the largest scattering cross-section for neutrons of any element and

has a high gamma ray absorption coefficient."

Appellant's specification also states that at the time of his invention the art recognized certain glass-forming compounds as "network formers" the melting of which in a glass batch

> * * * results in the formation of a skeleton or basic structure, which is a distorted or irregular network of cations such as silicon or boron ions bonded to one another by oxygen ions. Each silicon or boron ion is surrounded by four oxygen ions and since these ions form the basic network of the glass they are termed "network formers".

As to appellant's last constituent, the optional modifier, appellant's specification states:

> Modifying glasses * * * is well-known to those skilled in this art. Thus tantalum ions are added to glasses to raise their softening point, while the addition of thorium, lanthanum or tungsten ions increase[s] the dielectric constant. The addition of calcium oxides improves the workability of a glass and decreases its tendency to devitrify.

The percent by weight of one such modifier which appellant specifically discloses adding to his glass (tungsten oxide, WO_3) is stated as ranging "from a trace to 20%." Otherwise the modified batches of the two examples given consist of Bi_2O_3, CdO, and SiO_2.

We find ourselves somewhat at a loss, in view of the foregoing statements in appellant's specification, to determine therefrom just what aspect of his glass batch compositions he considers to be patentably significant. The "objects" stated in appellant's specification are not informative in this regard as they recite that it is desired that appellant's glasses possess such properties as a high refractive index, high dielectric constant, and others which the art would apparently expect them to possess from the use therein of cadmium and bismuth compounds, according to the recital in the specification of what the art already knew.

The claims on appeal are the only indication we can find in the application of what the appellant regards as his invention. Claim 1 is the broadest and claim 11 the most specific claim. They read:

> 1. An optical glass resulting from fusion of a batch of glass forming compounds, said batch consisting essentially of a compound to provide cadmium ions, a compound to provide bismuth ions, and a compound to provide network former ions.
>
> 11. An optical glass resulting from fusion of a batch of glass forming compounds having the following range of compositions by weight percent consisting essentially of:
>
> Cadmium oxide (CdO) trace to 75%
> Bismuth oxide (Bi_2O_3) 20 to 95%
> Silica (SiO_2) 0.5 to 20%

The issue as to the patentability of all the appealed claims has narrowed, on appeal to this court, to a single question: What is the significance of the words "consisting essentially of" which appear in the claims? Both appellant and the Patent Office appear to agree that the meaning in the patent law of these words was appropriately defined in the case of Ex parte Davis et al., 80 USPQ 448 (Bd), wherein reference was made to a "code" of terms drawn up by a group of examiners, one item of which reads (80 USPQ at 450):

> (3) recital of "essentially" along with "consisting of" [is regarded] as rendering the claim open *only* for the inclusion of unspecified ingredients *which do not materially affect* the basic and novel characteristics of the composition. [Emphasis ours.]

Speaking of the facts before it in the Davis et al. case, the board commented:

> In the present case where the claims recite three ingredients and the reference discloses four, the important question is whether the term "consisting essentially of" excludes that fourth ingredient. We think that it does, since the "modifier" *materially changes* the fundamental character of the three-ingredient composition * * *. [Emphasis ours.]

The sole reference relied on here by the Patent Office is

> Armistead 2,517,459 Aug. 1, 1950

The instant case presents facts very similar to those in the Davis et al case. A specific optical glass disclosed by Armistead includes silicon, cadmium, and bismuth oxides. But it *also* includes boric oxide (B_2O_3), berrylium oxide (BeO), and a mixture of calcium oxide (CaO) and strontium oxide (SrO). The examiner's rejection of the claims on appeal as restated by the board and its reasons for affirming it are as follows:

> Claims 1, 2, 3, 6, 7, 10 and 11 stand rejected as unpatentable over Armistead.
>
> We find no error in this rejection. The reference shows an optical glass in which silica and bismuth and cadmium oxides are present within the claimed proportions. The appellant states that other ingredients are present in the Armistead composition so that the glass of Armistead is an entirely different glass than appellant's. *In what respects its characteristics are different the appellant has not set forth.* The appellant has cited Ex parte Davis et al., 80 USPQ 448, but we do not see that the other ingredients of the Armistead glass *materially* effect the *basic* characteristics of appellant's glass. Since there is no showing of properties of the claimed optical glasses as patentably different from those of Armistead, this rejection of claims 1, 2, 3, 6, 7, 10 and 11 will be sustained. [Emphasis ours.]

Upon careful consideration of the whole record and the arguments of the parties, it does not appear to us that there are any *basic* or *novel* characteristics in appellant's claimed glass compositions by which they can be distinguished from Armistead's or which will serve, under the principle enunciated in Davis et al., to show that ingredients included by Armistead in his glass compositions in addition to those enumerated in appellant's claims, should be *excluded* by the phrase "consisting essentially of" common to appellant's claims.

Certainly no characteristics whatever are set forth in the claims, unless it be in the word "optical," which modifies "glass." Questioned as to the meaning or significance of this limitation at the argument, appellant's counsel said this was to signify that the composition is "vitrified." It being the essential nature of glass, by definition, to be vitrified,[1] we interpret this in the light of the statement in the specification that some "network formers" that were tried "did not form completely vitreous glasses, but did form partially devitrified glasses, i.e. glasses having crystals mixed therein." We suppose "optical" excludes glasses containing crystals, nothing more. We cannot regard this sole limitation, therefore, as significant in stating any basic or novel characteristic of appellant's glasses.

Armistead discloses "optical glasses" and he teaches that they may contain up to 60% cadmium oxide (CdO), to obtain beneficial effect upon the refractive index, and up to 20% bismuth oxide (Bi_2O_3) for the same purpose. These glasses contain silica, a source of "network former ions."

Appellant gives 21 examples of glasses containing ingredients named and within the ranges stated in his claim 11, demonstrating that their refractive indices, dielectric constants, and dissipation factors all vary over wide ranges. He does not prefer one over the other and he claims them all. In review he makes the following statement:

> Although a large number of glasses may be made from compounds containing cadmium ions, bismuth ions, and a network former in varying quantities, and the properties of such glasses will vary over a wide range, it is unlikely that among the many glasses which can be formed there will be a single glass which has all the properties desired for a particular application. Accordingly, a particular composition which has most of the properties desired is selected and it is then modified by adding modifiers to change its properties to conform as closely as possible to what is desired. Modifying glasses in this manner is well-known to those skilled in this art. Thus tantalum ions are added to glasses to raise their softening point, while the addition of thorium, lanthanum or tungsten ions increase[s] the dielectric constant. The addition of calcium oxides improves the workability of a glass and decreases its tendency to devitrify.

He then gives two examples of the use of up to 20% of tungsten oxide as a modifier and states:

> Thus I have provided a group of glasses having new compositions made from compounds containing both cadmium ions and bismuth ions, the remainder of the glass composition being a compound to supply network former ions and some modifier ions if necessary. I have shown that these glasses have high dielectric constants, and desirable optical properties as well as chemical durability. In addition, because they contain both cadmium and bismuth ions they are useful as neutron shields. In particular, the cadmium-bismuth boron glasses herein disclosed are useful for high energy neutron shielding. I have also indicated how these glasses may be modified to improve particular characteristics by the addition of modifying compounds to the batch from which the glass is fused.

[1] With this disclosure underlying his claims, it is our opinion that appel-

[1] Hackh's Chemical Dictionary, 3rd ed., defines "vitrification" as "The conversion of a material into a glass or glass-like substance, having increased hardness and brittleness;" "vitrify" is defined as "To sinter or melt to a glassy mass." "Glass" is defined as an amorphous material. "Amorphous" is defined to mean without form or non-crystalline.

lant is in no position to urge that they are so restricted by the phrase "consisting essentially of" that they define subject matter patentable over Armistead merely because the glasses of the reference contain some modifying ingredients in addition to silica, cadmium oxide and bismuth oxide. So may appellant's glasses. The word "essentially" opens the claims to the inclusion of ingredients which would *not* materially affect the *basic* and *novel* characteristics of appellant's compositions as defined in the balance of the claim, according to the applicable law. But no basic or novel characteristic to be so affected can be deduced from the disclosure and none was shown in brief or argument. We therefore find that the board was correct in holding that there is no showing of properties patentably distinguishing appellant's claimed glasses from those of the reference.

The decision of the board is *affirmed.*

Patent Office Trademark Trial and Appeal Board

GODMAN SHOE COMPANY v. DUNN & MCCARTHY, INC.

Decided Apr. 16, 1963

TRADEMARKS

1. **Marks and names subject to ownership — Descriptive — Particular marks (§ 67.5081)**

Picture of the goods is descriptive thereof; no one can assert exclusive rights to such representation.

2. **Evidence—Judicial notice (§ 67.335)**

Judicial notice is taken of definition of word in specific dictionary.

3. **Marks and names subject to ownership — Descriptive — Particular marks (§ 67.5081)**

"Cushion" is descriptive of shoes having a padded insole or other insert.

4. **Identity and similarity—Words and symbols (§ 67.413)**

Composite mark including shoe and "Cush Un Soft" is not so similar to composite mark including "Cushion-Step," "Arch Shoe," and shoe on cushion as to be likely to cause confusion.

Trademark opposition No. 40,076 by Godman Shoe Company against Dunn & McCarthy, Inc., application, Serial No. 66,980, filed Feb. 2, 1959. Opposition dismissed.

MASON, FENWICK & LAWRENCE, Washington, D.C., for Godman Shoe Company.

WENDELL W. FORBES, TOWNSEND J. KNIGHT, MARK N. DONOHUE, and BRUMBAUGH, FREE, GRAVES & DONOHUE, all of New York, N.Y. for Dunn & McCarthy, Inc.

Before LEACH, WALDSTREICHER, and SHRYOCK, Members.

WALDSTREICHER, Member.

Dunn & McCarthy, Inc. has filed an application to register for ladies' shoes the following:

Use since November 21, 1958 is asserted.

Registration has been opposed by Godman Shoe Company, registrant of the mark shown below, as applied to shoes for women.[1]

Opposer took no testimony but gave notice under Trademark Rule 2.123(c) that it will rely on an official abstract of title with respect to Registration No. 568,986 to establish ownership thereof.

The parties stipulated that a number of exhibits viz., two of applicant's catalogues, a photograph of a moving display promoting applicant's product, a copy of a memorandum distributed to applicant's salesmen, and a copy of applicant's advertising, may be accepted as being in evidence.

Applicant gave notice of reliance upon the discovery depositions of opposer's officers and a stipulation relating thereto; the file history of opposer's registration, and a number of third party registrations. Applicant also presented the testimony of its vice-president in charge of marketing and sales.

[1] Reg. No. 568,986, issued Jan. 13, 1953 to a predecessor.

Opposer is a manufacturer of women's shoes and it appears that opposer's predecessor in interest used the registered mark, as shown above, as early as 1934 to identify women's shoes, more particularly, arch shoes. Since 1950, opposer, through its predecessor, has used its registered mark for arch shoes and walking shoes, otherwise known as "mid-heel" shoes. It was estimated that, during the years 1958 and 1959, opposer sold between 20,000 to 30,000 pairs of shoes per year.

Applicant is also a manufacturer of women's shoes. Applicant sells its principal and premium line under the mark "ENNA JETTICK," a secondary and unadvertised line is sold under the mark "HEEL HUGGER-EVERYDAY."

As part of its "ENNA JETTICK" line, applicant manufactures a soft, light flexible shoe which is foam cushioned from heel to toe. Shoes of this particular construction are identified by the mark "CUSH UN SOFT." Applicant used the mark as originally sought to be registered from November 21, 1958 through December 1960. Since then, applicant has used only the designation "CUSH UN SOFT" as its mark for shoes of the construction heretofore described. "CUSH UN SOFT" shoes are sold through the usual shoe retail outlets including "ENNA JETTICKS" shoe stores. Sales of "CUSH UN SOFT" shoes have been nationwide and during the period November 1958 through December 31, 1961 applicant produced in excess of 1,400,000 pairs of shoes bearing the mark "CUSH UN SOFT." Applicant and its retailers have extensively advertised "CUSH UN SOFT" shoes to the general public. Additionally, there has been substantial promotion of "CUSH UN SOFT" shoes to the trade.

There is no question of priority and the products of the parties are, albeit, of different construction, ladies' shoes. The sole issue is whether applicant's mark so resembles opposer's mark as to be likely to cause confusion or to cause mistake or to deceive.

Opposer submits that the resemblances between the marks are so numerous that it must be concluded that, when used on the identical products, the marks are likely to confuse people.

Applicant takes the position that opposer's mark is a "weak" mark being composed of generic and highly descriptive components and that therefore opposer's enforceable rights in it are narrowly circumscribed.

What are the asserted points of similarity between the marks? Opposer's mark includes a representation of a ladies' shoe resting on a cushion and it is asserted that the design feature of applicant's mark represents a ladies' shoe resting on a pillow. Opposer equates the design feature of applicant's mark with certain of applicant's advertising material comprising a kitten flexing a ladies' shoe resting on a cushion. The design feature of applicant's mark does not approximate that advertising material. The design, as we see it, does not represent a cushion, nor do we think that purchasers will so suppose. It appears to us as merely an abstract design. As to the representation of the shoe, certainly [1]a picture of the goods is descriptive thereof and no one can assert any exclusive rights to such a representation.

[2] The designation "CUSH UN" in applicant's mark is but the equivalent of the word "CUSHION" forming part of opposer's mark. As defined in Webster's Third New International Dictionary 1961, of which we take judicial notice, the word "cushion" means, inter alia, "a padded insole; a padded insert in a shoe at the ball or heel". It is evident that the [3] term "cushion" as applied to shoes is not arbitrary but is highly descriptive of shoes having a padded insole or other insert. Further, the record shows that marks comprising the word "cushion" or a phonetic equivalent have been commonly adopted for shoes. Opposer's president testified to his familiarity with a large number of marks including the term "CUSHION" used in connection with shoes, at least one of which admittedly was used more than forty years ago. Opposer's vice-president testified that he has been maintaining a file of third party registrations disclosing marks containing the word "cushion" and that such file "is a very thick file."

[4] Considering the marks in their entireties, the total appearance of applicant's mark is substantially different from the total appearance of opposer's mark. The word portions of each bear some similarity in sound essentially because of the inclusion in each of the word portions of the marks of a commonly used descriptive designation which no producer or seller of shoes can monopolize. The remaining word features of the marks are dissimilar. The dissimilarities there between the marks as a whole are sufficient to obviate any likelihood of confusion. It is concluded that the marks are not likely to cause confusion or to cause mistake or to deceive.

Decision

The opposition is dismissed.